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09/559,704	04/27/2000	Michael D. Zoeckler	7137	2557

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GRAPHIC PACKAGING INTERNATIONAL, INC.
814 LIVINGSTON COURT
MARIETTA, GA 30067

EXAMINER

HARMON, CHRISTOPHER R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/559,704
Filing Date: April 27, 2000
Appellant(s): ZOECKLER, MICHAEL D.

MAILED
OCT 06 2006
Group 3700

Keats A. Quinalty
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/3/06 appealing from the Office action
mailed 4/19/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Pending appeals in U.S. Application No. 09/971,469 and 09/818,023

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1,880,288	Stokes	10-1932
5,147,480	Lang	9-1992
1,600,396	Campbell et al.	9-1926

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 11-16, 25-29, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Stone (US 5,551,938).

Stone discloses a method for forming carton blanks comprising advancing a web of paperboard 42 along a path; progressively applying, with an adhesive, at least one ribbon of reinforcing material 38 with a width less than the paperboard substantially overlying a selected panel portion (56); the paperboard is then cut into individual carton blanks and then are formed into cartons for receiving articles (see figures 1-3). Stone teaches manufacturing a paperboard carton with a reinforcing collar made of "either paperboard, thick paper...or flexible plastic." (column 4, lines 48-49). Therefore paperboard trim, cull, etc. is considered anticipated by Stone.

Regarding claims 16 and 34 note: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the

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product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7, 9-11, 16, 25, 29-32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang (US 5,147,480) in view of Campbell et al. (US 1,600,396).

Lang discloses a method of making paperboard cartons comprising advancing a web of paperboard 48 to a laminator/reinforcer, which applies at least one layer of material to the paperboard; see figures 3 and 4. The web is then cut/scored and then formed into cartons. Lang discloses printing on the reinforcing layers.

Lang does not disclose the use of laminating non-corrugated material, however Campbell teaches reinforcing non-corrugated paperboard as well as corrugated paperboard; see column 1 lines 1-5 and 37-44. It would have been obvious to a person of ordinary skill in the art to use the method of Lang on non-corrugated paperboard as described by Campbell.

Claims 4-7 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone (US 5,551,938) in view of Stokes (US 1,880,288).

Stone does not disclose a plurality of reinforcing ribbons, however Stokes teaches reinforcing carton blanks with ribbons (t); see figures 1-1a. It would have been obvious to one of ordinary skill in the art to use the teachings of Stokes in the invention to Stone in order to reinforce more than one side of the carton for greater strength.

(10) Response to Argument

Applicant's arguments filed 8/3/06 have been fully considered but they are not persuasive.

A) Regarding the 102(b) rejection anticipated by Stone '938:

Stone discloses reinforcing substantially all of panel portion 56 by adhering the strip 38 (see figures 2 and 3). Stone discloses "only one or more of the panels 56, 58, and 60 are bonded to the carton blank 44." (column 6, lines 54-55). Thus the adhesive application of reinforcing ribbon/strip 38 overlies "substantially all" of this panel portion.

The language "substantially all of a selected panel portion of the web" is extremely broad. Note: During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). See MPEP § 904.1. Therefore any **portion** of any panel that is adhered to and covered by another (reinforcing) layer could be reasonably selected. Thus the overlying material of Stone adheres to substantially all of a selected panel portion 56 and anticipates the limitation. The argument that the only

area below tear strip 27 is adhered to by the strip 38 is an admission that substantially all of this selected panel portion (ie. 56 below the tear strip 27) has been adhered to.

Note: appellant seems to be arguing that all of a panel (as opposed to a panel portion) is required to be adhered to. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Stone specifically discloses modifying the width of the reinforcing collar 24 (also reinforcing strip 38) providing “the collar 24 may be modified so that the collar is relatively narrow... or relatively wide” column 6, lines 43-44. Widening of the strip 38 would anticipate applicant’s narrow interpretation of this limitation ie. the smallest “selected panel portion” 50 would be substantially covered and adhered to by reinforcing material 38; see figure 3.

In addition, Stone recognizes the capability of using a “full height liner”, however does not explicitly teach an embodiment (which would presumably adhere to and cover all of every panel portion) in order to save material; see column 2, lines 25-27.

B) Regarding the 103(a) rejection over Stone '938 and Stokes '288:

The factors recognized in *Graham v. Deere* (1966) were considered and followed in making the rejection under 103(a). Stone does not fail to disclose any limitations of 1 or 25; as noted supra. The differences between Stone and the claims at issue involve merely applying a plurality of ribbons of reinforcing material. Stone recognizes reinforcing a selected panel portion of carton blanks, see column 1, lines 25+. In

response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Stone '938 is concerned with strengthening panel portions of a container and creating a lid, which can be securely opened and closed repeatedly (see column 1, lines 16-19). Stone accomplishes this by press bonding multiple laminates together; see figure 2). Stokes is also concerned with reinforcing containers and also uses a laminating technique. Laminating with multiple laminates is well established and generally available as is specifically taught by Stokes. If a container thus required further strengthening or reinforcement, one of ordinary skill in the art could easily conclude to apply multiple laminates.

C) Regarding the 103(a) rejection over Lang '480 in view of Campell et al. 1,600,396),

Applicant's is arguing the limitation of "non-corrugated paperboard" as an essential limitation to the claimed invention. This is not persuasive. The limitation claiming "non-corrugated paperboard" in order to exclude other forms of paperboard (ie. corrugated) was in response to overcome a final rejection filed with a Request for Reconsideration 3/15/04. Nothing in the summary of the invention (specification pages

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8-12) details the essential nature of the paperboard used in the method to be non-corrugated. The specification briefly discusses the problems with construction using micro-fluted paperboard (pages 4-8) however, nothing in the detailed description of the specification pages 13-17 differentiates paperboard web 17 as being "non-corrugated".

In contrast applicant, in describing paperboard reinforcing ribbons, states in page 17, lines 7-11 of the specification "It should be understood, however, that the term "paperboard" when used in this context is intended to encompass and include any material with the physical and mechanical attributes necessary to provide the requisite reinforcing properties."

Applicant has set a broad enough foundation for claiming "non-corrugated" paperboard, thereby excluding "corrugated" paperboard, however also sets forth a broad range of alternatives capable of being interpreted as "paperboard". Such a depiction does not coincide with the argument that a "non-corrugated" paperboard material cannot be easily substituted with an alternative nor would one of ordinary skill in the art fail to be capable of ascertaining such a substitution.

Further note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. One having ordinary skill could easily determine physical differences between variations of paperboard eg. strength, pliability, etc.

Paperboard is well known to comprise many alternatives (as indicated by applicant in the specification) including but not limited to corrugated and non-corrugated types:

pa·per·board (pâ'per-bôrd', -bord') *noun*
Cardboard; pasteboard.¹

In view of this Campbell et al. (US 1,600,396) teaches corrugated paperboard and non-corrugated paperboard as well known alternatives for manufacturing containers in the art (see above) as well as many other cited references in the prosecution history ie. Anderson '117, Confer '538, Smith '702.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would be fully capable of recognizing using other types of web material in the method to Lang. Campbell et al. directly teach reinforcing both corrugated and non-corrugated materials by the same method in order to produce products.

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D) Regarding applicant's affidavit filed 3/15/04,

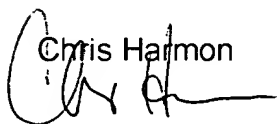
The affidavit was previously entered and considered and was not persuasive as a secondary consideration. The weight to be accorded to the evidence depends on the individual factual circumstances of each case. *Stratoflex, Inc. v. Aeroquip Corp.*, (Fed. Cir. 1983); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). The ultimate determination on patentability is made on the entire record. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Note "Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed.Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988)." See MPEP 716.03. Therefore the "McLary Declaration" is not objective evidence of commercial success and not persuasive.

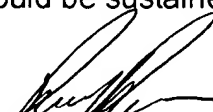
(11) Related Proceeding(s) Appendix

No decisions by the Board of Patent Appeals have been filed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Chris Harmon


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Supervisory Patent Examiner
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Conferees:

Rinaldi Rada SPE 

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